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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,144

Applicant(s)

GARRAD ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 07 April 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Specification

Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 4-07-03 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the invention as claimed in claims 1-21, e.g. where is the transfer layer? Where is the wing as claimed in combination with the layer portion and silhouette as claimed? Where are the layers of the wing? The “garment attachment means”? The “absorbent article attachment means”?, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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Description

3. The disclosure is objected to because of the following informalities: 1) The Summary of the Invention section and the invention as claimed are still not commensurate in scope, e.g. on page 3, lines 22-25, where is the article described as a thong pantiliner? Is line 24 missing a word after "attachment"? 2) In the amendment to page 2, line 24, line 1 thereof seems to be missing a word or words.

Appropriate correction is required.

4. It is also noted that Applicant seems to be invoking 35 USC 112, sixth paragraph interpretation in claims 5-8 and 17-18, see lines 3-5 of claim 5. When invoking such, Applicant must disclose corresponding structure in the specification in a way that one skilled in the art will understand what structure will perform the recited function. While one skilled in the art would recognize that the structure set forth in the paragraph to page 11, line 21, lines 5-7 and 14 thereof performs the function recited in the claims of the garment attachment means and the absorbent article attachment means, it is suggested that the written description be amended to explicitly state such, provided no new matter is introduced.

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Claim Objections

5. Claims 1-4 and 6-21 are objected to because of the following informalities: in claims 2-4, 6-8 and 10-21, line 1, "A" or "An" should be --The--. In claim 1, line 16, before "longitudinally", --first or second-- should be inserted. In claim 2, line 2, before "group", --the-- should be inserted. In claim 9, line 12, before "layered", --a-- should be inserted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. Claims 7-8 and 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is still unclear whether Applicant is claiming the subcombination of the wing, see preambles, or the combination of the wing and a pantiliner, see claim bodies of claims 16-18 and 7-8. Note also Applicant's remarks at page 15, lines 28-30 of the 4-7-03 response.

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Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-4, and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Hammons et al '484.

First portion is 42 or 44, second portion is 45 (It is noted that the claim language does not require opposite first and second end portions and "opposite" as defined by the American Heritage Dictionary, i.e. the ordinary definition, is "facing the other way, moving or tending away from each other" and portion 45 faces away from portion 42 or 44), edges are adjacent 161 and 160 in Figure 41, the core is 24, see paragraph 65, the back sheet is 26, see paragraph 64, the cover is 22, see paragraph 68, the transfer sheet is disclosed in paragraph 77, the wing is 34 or 36 (It is noted that it is not required that the wing extend directly from and releaseably attach directly to the edge), releasable attachment of the wing is disclosed, e.g., in paragraphs 160-164. With regard to claim 2, this claim is a product by process claim. If the process is not already disclosed

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by Hammons, see, e.g. paragraph 162 thereof, it is noted that patentability is based on the end product itself not the method of production. The product of Hammons et al is the same and thus the claim is unpatentable even if the product is made by a different process. See MPEP 2113. It is further noted that the claims 1, 3-4 and 14-15 are broad enough that it reads on Hammons et al without the flap severance feature because the flap 34 is releaseably attached to the side edge adjacent flap 36 by fasteners 52, 54 and flap 36. With regard to claim 13, at the very least, the perforation 160 is between flap 36 and the edge adjacent flap 34 so severance along line 160 would not only release flap 34 but also flap 36 from that edge.

9. Claims 1-4 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark et al, '137.

First portion and second portion are disclosed at col. 4, line 50 (It is noted that the claim language does not require opposite first and second end portions and "opposite" as defined by the American Heritage Dictionary, i.e. the ordinary definition, is "facing the other way, moving or tending away from each other" and middle portion of hourglass shape faces away from an end of the shape), edges are edges of at least one upper pad 50 adjacent 51 as seen in Figure 5, the layered portion is one of the upper pads 50 wherein the core is 24, see col. 5, lines 53-55 and col. 6, line 13, the back sheet is 26, the cover or transfer layer is 22, the wing is at the very least 51 and at the most the entire lower pad 50, releasable attachment of the wing is disclosed at col. 8, line 23-col. 12, line 48, i.e. the attachment means allows releasable attachment of the wing 51 to the uppermost pad 50 or the middle pad 50. With regard to claim 2, this claim is a product by

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process claim. If the process is not already disclosed by Clark, see, e.g., portions cited supra, it is noted that patentability is based on the end product itself not the method of production. The product of Clark et al is the same and thus the claim is unpatentable even if the product is made by a different process. See MPEP 2113. With regard to claim 13, it is noted that each wing is attached to and extends from each edge, i.e. directly or indirectly. Thus the perforations adjacent one flap are between the other flap and that edge and that edge is released from the other flap by such perforations.

10. Claims 5-8 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Maulhardt, DE '026.

See Figures, especially Figure 3. The wing is 6, the upper surface of which is cover 10 and an adhesive layer 12 and the lower surface of which is adhesive layers 14. See also page 5, second full paragraph and page 9, lines 1-3 of the translation. Claim 5, line 1, claims 7-8 and now 16-18 as best understood, recite capability or function, i.e. capability of securement to a pantiliner having such claimed specifics and to a garment. However since the Maulhardt device includes all the claimed structure, there is reasonable factual basis to for one to conclude that the function and capability or such structure would also be inherent in the same structure of Clark. See MPEP 2112.01. See also discussion of Applicant's remarks *infra*. With regard to claim 6, i.e. the process of dispensing the product from a roll, i.e. a product by process claim, see discussion of claim 2 above which discussion also applies to this product by process claim.

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11. Claims 9-12 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Bien '929.

See Figures, first portion, at the very least, is adjacent one of the ends, second portion is center portion (It is noted that the claim language does not require opposite first and second end portions and "opposite" as defined by the American Heritage Dictionary, i.e. the ordinary definition, is "facing the other way, moving or tending away from each other" and center portion faces away from first portion), edges are 22, the core is 32, see col. 4, line 22, the back sheet is 30, see col. 4, lines 60-65, the cover is 28, the transfer sheet is disclosed at col. 8, lines 25-28 which incorporates Osborn '264, and thus col. 8, lines 16-56 thereof, the wing is the flap disclosed at col. 7, line 29-col. 8, line 16, which incorporates Mattingly, e.g., shows that the shape of the article can have one larger end portion and one smaller end portion and a still smaller middle portion with a wing. With regard to the preambles of the claims, the structure of the "kit" claimed is taught by Bien. See also discussion of Applicant's remarks *infra*. With regard to claim 10, this claim is a product by process claim. Patentability is based on the end product itself not the method of production. The product of Bien is the same and thus the claim is unpatentable. even if the product is made by a different process. See MPEP 2113.

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Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al '137 in view of Bien.

Applicants claim the pantiliner having a breathable backsheet. While Clark et al teaches a backsheet such is not disclosed as breathable but is disclosed at col. 8, lines 13-14 as being any film useful in the art. See col. 4, lines 43-65 of Bien, i.e a backsheet of plastic film which is breathable and is useful in the art. To make the backsheet of Clark et al breathable as taught by

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Bien would be obvious to one of ordinary skill in the art in view of the recognition that such is a plastic barrier film useful in the art and the desire of Clark et al to employ such a film.

Response to Arguments

14. Applicant's remarks on pages 8-13 of the 4-7-03 response with regard to the informalities have been noted but are either deemed moot in that the discussed issues have not been reraised or are deemed nonpersuasive for the reasons set forth above. Prior to discussing the prior art references it is noted that Applicants have not provided any specific definition for any of the claim terminology. Therefore, the ordinary meaning, i.e. dictionary definition, is considered to apply to such terminology. Applicant's remarks on pages 13-15 of the 4-7-03 response with regard to Bien have been considered but with regard to claims 1-4 are deemed moot in that the rejection has not been reraised at this time due to the amendments to the claims. With regard to claims 9-12, while the Examiner believes that the portions of Bien cited in the last Office Action and the comments therewith addressed all set forth all the claimed structure and function, the Examiner has provided more detail in the rejection supra due to Applicant's confusion. It is noted that the Examiner did not cite other documents, e.g. Osborn and Mattingly, but rather Bien incorporated such into the reference and therefore Bien does include the same structure as stated by the Examiner. It is noted claims 9-12 do not recite perforations. It is also noted that the term "kit" does not further distinguish the structure of the claims set forth therein over Bien as Applicant appears to argue. It is noted that "kit" as defined by the American Heritage Dictionary is "a set of

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articles used for a specific purpose". The purpose set forth is "a absorbent article". Bien teaches a set of articles or elements used for the specific purpose of an absorbent article, i.e a "kit for a absorbent article". If Applicant continues to traverse the rejection on this basis it is requested that the specific claim language which distinguishes the claim from Bien be specifically set forth.

Applicant's remarks with regard to Maulhardt have been considered but are deemed nonpersuasive because the rejection was not a rejection under 103. In any case, The Examiner has set forth what is considered the cover. It is noted that the claims do not require any layers other than the upper surface which is a cover and adhesive and a lower surface which is adhesive. Applicant further argues that the claims require the attachment wing attach a pantiliner to a garment. This is inconsistent with applicant's position bridging pages 12-13. As best understood the claims require a wing for attaching a thong pantiliner to a garment, i.e capability or function. See rejection supra. Even, as noted above, considering claim 5, lines 3-5 to invoke 112, sixth paragraph, does not distinguish over Maulhardt. Means plus function language is construed to encompass the corresponding structure, material or acts described in the specification and equivalents thereof. Applicant claims means for securing the wing to the thong pantiliner and means for attaching the wing to the garment. The corresponding structure, material or acts in the written disclosure necessary to perform that function as one skilled in the art would understand are set forth in the paragraph bridging pages 11-12, i.e. adhesive acts as both the means. The Maulhardt device shows adhesive, i.e the structural equivalent, used to attach to a napkin and a garment, i.e. the adhesive of Maulhardt is an equivalent to the means plus function limitation.

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14. Finally it is noted that Noel et al cited by the Examiner the last time teaches the interchangeability of a pear or thong shape, i.e an asymmetrical shape, for any other shape, e.g symmetrical shapes, see col. 6, lines 3-12 and 46-54. Also it is noted that Hammons et al at Figure 42 and paragraphs 165-168 teaches a connector piece which could be considered an attachment wing combined in a package with a plurality of napkins.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited shows various wings.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any new grounds of rejection were necessitated by Applicant's amendments to the claims, e.g., claims 1, and 3-4 no longer require perforations, claim 2 no longer requires a cover, claims 1, and 3-4 no longer require a cover, the addition of claims 13-21.

17. Any inquiry concerning this communication should be directed to K. M. Reichle at telephone number 703-308-2617. The Examiner's regular work schedule is Monday-Thursday. The Official RightFAX number is 703-308-2617.

K.M. Reichle
K.M. REICHEL
EXAMINER

KMR

July 7, 2003